| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/656,931 | 09/05/2003 | Heather Ellen Bergeron | HES-003CP1 | 8379 |

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| EXAMINER |
|---|
| REYES, REGINALD R |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3626 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/06/2009 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/656,931 | BERGERON ET AL. |
| | Examiner | Art Unit | |
| | REGINALD REYES | 3626 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>05 September 2003</u>.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-18</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9-5-2003</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

### *Status of Claims*

1.     Claims 1-18 have been examined.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.     Claims 1-18 are rejected under 35 U.S.C. §101 because the claimed invention is

directed to non-statutory subject matter.  Based on Supreme Court precedent (See also

*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9

(1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S.

780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be

tied to another statutory class (such as a particular apparatus) or (2) transform

underlying subject matter (such as an article or materials) to a different state or thing. In

addition, the tie to a particular apparatus, for example, cannot be mere extra-solution

activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process

would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory

class (the thing or product) to which it is tied.   This may be accomplished by having the

claim positively recite the machine that accomplishes the method steps.  Alternatively or

to meet prong (2), the method step should positively recite identifying the material that is

being changed to a different state or positively recite the subject matter that is being

transformed.

In this particular case, claim 1 fails prong (1) because the "tie" (e.g. receiving at a

computer) is representative of extra-solution activity. Additionally, the claim(s) fail prong

(2) because the method steps do not transform the underlying subject matter to a

different state or thing.


### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.        Claims 1-2, 6-9, 11-17 are rejected under 35 U.S.C. 102 (b) as being anticipated

by Guheen et al (6,721,713).

4.        With respect to claim 1 and 14 Guheen teaches a method, comprising: identifying

indicia associated with a plurality of entity types (see for example Guheen column 2

lines 24-30); identifying at least one relationship affecting interactions between the

plurality of entity types (see for example Guheen column 8 lines 5-22); identifying a

plurality of transactions associated with at least one of the interactions (see for example

Guheen column 63 lines 9-15); organizing the plurality of transactions into at least one

transaction sequence (see for example Guheen column 41 lines 56-62); and associating

the identified indicia, the at least one identified relationship, and the at least one

transaction sequence to form a semantic network, wherein an instance of the semantic

network is formable based, at least in part, on a detection of the at least one interaction

(see for example column 7 lines 67-67 and column 8 lines 1-40).


5.      With respect to claim 2 Guheen teaches the method of claim 1 (as described

above).  Guheen teaches wherein the plurality of entity types correspond to at least two

different entities interacting in an industry (see for example column 10 lines 61-67 and

column 11 lines 1-11).


6.      With respect to claim 6 Guheen teaches the method of claim 1 (as described

above).  Guheen teaches further comprising: storing the identified indicia in a data

structure; and assigning a version number to the data structure (see for example

Guheen column 9 lines 18-25).


7.      With respect to claim 7 Guheen teaches the method of claim 1 (as described

above).  Guheen teaches further comprising: receiving the identified indicia from an

electronic data interchange system (see for example Guheen column 9 lines 18-25).


8.      With respect to claim 8 Guheen teaches the method of claim 1 (as described

above).  Guheen teaches further comprising: receiving the identified indicia from at least

one of an application program interface, a user interface, and a software editing tool

(see for example Guheen column 9 lines 18-30).

9.      With respect to claim 9 and 11 Guheen teaches the method of claim 1 (as

described above).  Guheen teaches further comprising: representing the identified

indicia in a natural language format exhibiting a fixed context and a fixed grammar (see

for example Guheen column 61 lines 1-22 and column 103 lines 13-19).


10.     With respect to claim 12 Guheen teaches the method of claim 9 (as described

above).  Guheen teaches further comprising: parsing the natural language

representation of the identified indicia into a plurality of fields; and mapping at least

some of the fields into at least one data structure (see for example Guheen column 27

lines 38-47).


11.     With respect to claim 13 Guheen teaches the method of claim 12 (as described

above).  Guheen teaches further comprising: assigning a version number to the at least

one data structure (see fore example column 9 lines 18-25).


12.     With respect to claim 15 Guheen teaches the method of claim 1 ( as described

above).  Guheen teaches wherein the at least one interaction is associated with at least

one of a request for payment of services performed, a request to authorize proposed

services, a request to enroll a service provider, a request to enroll a service purchaser,

a request to enroll a service beneficiary, and an adoption of a new contract (see for

example Guheen column 135 lines 17-20).

13.    With respect to claim 16 Guheen teaches the method of claim 1 (as described above).  Guheen teaches further comprising: forming an electronic message in response to detecting an error associated with the identified indicia (see for example Guheen column 141 lines 47-49 and column 219 lines 19-30).

14.    With respect to claim 17 Guheen teaches the method of claim 1 (as described above).  Guheen teaches wherein the identified indicia correspond to a plurality of nodes in the semantic network and the at least one identified relationship corresponds to links interconnecting at least some of the plurality of nodes in the semantic network (see for example column 106 lines 40-43).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15.    Claims 3-5 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Guheen et al (6,721,713).

16.    With respect to claim 3-5, Guheen teaches the method of claim 2 (as described above).  With respect to " wherein the industry is a service-based industry and the at least two different entities correspond to at least two of a service provider, a service

implementer, a service purchaser, a service beneficiary, a service maintainer, and a

service regulator" is a wherein clause therefore it has been held where in clauses,

according to the MPEP, in a method claim is not given weight when it simply expresses

the intended result of a process step positively recited" (Minton v. Nat'l Ass'n of

Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir.

2003))". Also, a (whereby/wherein) clause that merely states the result of the limitations

in the claim adds nothing to the patentability or substance of the claim ((Texas

Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993);

Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v.

Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)).


17.     With respect to claim 18 Guheen teaches the method of claim 1 (as described

above). Guheen teaches further comprising: querying data structures associated with

the semantic network; and forming an electronic document containing at least some of

the identified indicia and data associated with the at least one identified relationship in

response to the query of the data structures (see for example Guheen column 65 lines

14-24). With respect to " wherein the electronic document is viewable in a natural

language format exhibiting a fixed context and a fixed grammar "is a wherein clause

therefore it has been held where in clauses, according to the MPEP, in a method claim

is not given weight when it simply expresses the intended result of a process step

positively recited" (Minton v. Nat'l Ass'n of Securities Dealers, Inc., 336 F.3d 1373,

1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003))". Also, a (whereby/wherein) clause that

merely states the result of the limitations in the claim adds nothing to the patentability or

substance of the claim ((Texas Instruments Inc. v. International Trade Commission 26,

USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002);

Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)).


18.     Claim 10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over

Guheen et al (6,721,713) in view of Tabbara et al (U.S. 6,460,043).

With respect to claim 10 Guheen teaches the method of claim 9 (as described above).

Tabbara does not teach wherein the fixed grammar exhibits a Backus-Naur format.

Tabbara teaches the grammar being of Backus-Naur format (see Tabbara column 18

lines 41-51).  It would have been obvious to one of ordinary skill in the art at the time of

invention to combine the methods for processing as presented by Guheen with the

grammar type specified in Tabbara.  The motivation to have combined the references is

for data extraction by a computer is commonly used for a grammar defining command

structure.


### Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.  U.S. PG Pub 2002/0161674 a method for fulfilling an order in an

integrated supply chain management.

U.S. Patent No. 6,757,672 teaches modifying a relational database.

U.S. Patent No. 6,366,934 teaches method and apparatus for querying structured documents using a database extender.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD REYES whose telephone number is (571)270-5212. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/R. R./
Examiner, Art Unit 3626

/C. Luke  Gilligan/

Supervisory Patent Examiner, Art Unit 3626